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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,999	08/14/2001	Peter H. Gien	10003-052-999	8052
20583	7590	11/03/2005	EXAMINER TESLOVICH, TAMARA	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			ART UNIT 2137	PAPER NUMBER

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/928,999

Applicant(s)

GIEN ET AL.

Examiner

Tamara Teslovich

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/26/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>04.12.02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-17 are herein considered.

Claims 18-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on July 26, 2005.

Specification

Applicant fails in line 1 of page 5 of the Specification to provide the US Patent Application Serial number for the application files on August 14, 2001 entitled "System and Method for Providing Warranties in Electronic Commerce" and in line 26 of page 5 of the Specification to provide the US Patent Application serial number for the application filed on August 14, 2001, entitled "System and Method for Facilitating Signing by Buyers in Electronic Commerce". The Examiner requests that the Applicant submit an amendment to the Specification providing the required information.

Claim Objections

Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 4 depends from claim 3, specifying that the trusted entity be an 'issuing participant'. However, claim 4

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depends on claim 3, which depends on claim 2 which already requires that the hardware token be issued by the trusted entity, which would suggest that the trusted entity be an 'issuing participant' or order to issue hardware tokens and the like.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-17 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 5,668,878 to Stefanus Alfonsus Brands.

Regarding claim 1, Brands teaches a method for facilitating secure hardware token issuance and use, comprising storing an only instance of a private ("secret") key on the hardware token ("tamper resistant computing device"), the hardware token being adapted to prevent the private key from being exported from the hardware token (col.5 lines 13-16), binding the private key to a subscriber with a digital certificate (col.8 lines 56-64; col.10 lines 6-17), creating a contract establishing ownership over the physical manifestation of the private key, and using the private key to create a digital signature on the hardware token (col.4 lines 23-47; col.10 lines 19-49).

Regarding claim 2, Brands teaches wherein the hardware token is issued by a trusted entity (col.11 line 65 thru col.12 line 17; col.15 lines 26-31; col.16 lines 4-14).

Regarding claim 3, Brands teaches wherein the contract specifies that the physical manifestation of the private key is owned by the trusted entity (col.16 lines 4-36).

Regarding claim 4, Brands teaches wherein the trusted entity is an issuing participant (col.11 line 65 thru col.12 line 17; col.15 lines 26-31; col.16 lines 4-14).

Regarding claim 5, Brands teaches wherein the contract specifies that the physical manifestation of the private key is owned by a root entity (col.7 lines 55-67 col.8 lines 13-14, 29-38).

Regarding claim 6, Brands teaches wherein the contract specifies that the physical manifestation of the private key is owned by the subscriber (col.7 lines 55-67 col.8 lines 13-14, 29-38).

Regarding claim 7, Brands teaches wherein the hardware token is a smartcard (col.8 lines 25-27).

Regarding claim 8, Brands teaches wherein the hardware token is a PCMCIA device (col.8 lines 25-27).

Regarding claim 9, Brands teaches wherein the private key is an identity private key (col.11 lines 1-6).

Regarding claim 10, Brands teaches wherein the hardware token comprises means for monotonically counting each time the private key is used to create a digital signature (col.10 lines 1-5).

Regarding claim 11, Brands teaches wherein the hardware token comprises means for permanently storing a PIN/passphrase (col.7 lines 55-67).

Regarding claim 12, Brands teaches wherein the subscriber must enter the PIN/passphrase before a digital signature is generated (col.13 lines 45-67).

Regarding claim 13, Brands teaches wherein the subscriber must enter PIN/passphrase each time a digital signature is generated (col.12 line 59 thru col.13 line 14).

Regarding claim 14, Brands teaches wherein the digital signature comprises security data (col.9 lines 16-24).

Regarding claim 15, Brands teaches wherein the security data is signed to create a security-data cryptogram (col.10 line 31 thru col.11 line 6).

Regarding claim 16, Brands teaches wherein the security-data cryptogram is generated using an algorithm different than the one used to create the digital signature (col.10 line 31 thru col.11 line 6).

Regarding claim 17, Brands teaches wherein the security data comprises data that is the subject of the digital signature (col.9 lines 16-24; col.9 lines 33-36).

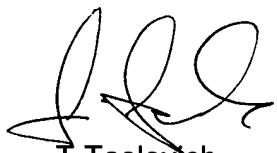
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure because they serve as examples of Smartcard systems and qualities and specifications inherent to such systems.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara Teslovich whose telephone number is (571) 272-4241. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



T. Teslovich
October 30, 2005



EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER